

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nancy I. Saxon Art Unit: 3616
Serial No.: 10/658,306 Examiner: Ilan, Ruth
Filed: 09/09/2003 Attorney Docket No.: 60130-1626; 02MRA0440
Title: REINFORCED TRACTOR-TRAILER SLIDER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This is in response to the Examiner's Answer, mailed on August 8, 2007.

I. There is no motivation to modify Robey to provide the hangers of Vandenberg.

Preliminarily, the Appellant points out that the Examiner misapplies KSR in making the rejections. KSR did hold that the teaching, suggestion, or motivation test should not be rigidly applied. However, KSR also held:

“Therefore, in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

Thus, the Examiner must provide a “reason why” a person of ordinary skill in the art would combine the elements, just as has been the case prior to KSR.

Referring specifically to the rejection over Robey and Vandenberg, the issue is that the Examiner relies upon supposed teachings in Vandenberg for the reason why the elements should

be combined. It is the Appellant's position that Vandenberg, in fact, does not provide or support the Examiner's reason.

First, the Examiner's statement that the use of hangers would "logically and obviously" follow is only conclusory and does not provide an actual reason. Second, the portions of Vandenberg cited by the Examiner do not relate to the use of hangers but rather the stabilizer bar and bushings. This point is addressed more fully in the Appellant's appeal brief in the first full paragraph on page 5. Third, the fact that parallelogram suspensions may be used without hangers is not "moot." Here, the Examiner falls victim to the very rigid application of teaching, suggestion and motivation test to which he complains. The Examiner must look to the teachings of the art as a whole, which includes art outside of the cited references. Additionally, Appellant's mention of parallelogram suspensions without hangers does not limit the skilled person's options to only two suspension configurations. There are others, such as parallel upper and lower control arms and many other. Nonetheless, KSR requires the Examiner to provide a reason why one of ordinary skill would use a hanger. The Examiner has not provided a valid reason.

II. There is no motivation to modify Christenson to provide the hangers of Hutchens.

Here, the issue is that Christenson does not disclose or teach any particular type of suspension arrangement. Figure 1 and figure 7 do not enable one of ordinary skill to discern whether the use of a hanger could be of any benefit or use in Christenson. Thus, there is no reason why one of ordinary skill would combine the elements. It is impossible for the Examiner to conclude that it would be of benefit in Christenson to utilize a hanger of Hutchens. The teachings in Hutchens regarding minimizing number of parts and fabricating steps apply only to those suspension configurations already using hangers that are bolted onto the side rails (see column 1, of Hutchens). There is no way of knowing whether Christenson uses bolted-on hangers. As a result, there is no reason why one of ordinary skill would use Hutchens' hangers in Christenson.

III. There is no motivation to modify either Christenson, Hutchens or Garcia with the triangular shaped braces of Pierce.

Upon reviewing the cited references, one of ordinary skill would clearly recognize that braces are not used at every joint. In fact, braces are hardly used at all. Why? The use of braces adds weight, cost and time. Accordingly, it is evident that one of ordinary skill would only use a brace when absolutely needed, or said another way, when there is a reason why a brace would be necessary at a particular location. The Examiner has not given a reason why one of ordinary skill would use a brace as claimed. The Examiner relies on the Appellant's application and its teachings and then applies hindsight in making the rejection.

For the reasons set forth above, the final rejection of these claims is improper and must be reversed. If any fees or extensions of time are required, please charge to Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds.

Respectfully Submitted,
CARLSON, GASKEY & OLDS, P.C.

/William S. Gottschalk/
William S. Gottschalk
Registration No. 44,130
400 West Maple, Suite 350
Birmingham, Michigan 48009
(248) 988-8360

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